

REMARKS

The Examiner is thanked for the clarity and conciseness of the Office Action, and for the citation of references, which have been studied with interest and care.

This Amendment is in response to the Office Action mailed January 29, 2003. In the Office Action, the Examiner objected to the (i) drawings and the (ii) specification and rejected (i) claims 4-11 under 35 U.S.C. §112, second paragraph, and (ii) claims 1, 4, 5, and 7-42 under 35 U.S.C. §103.

Applicant has cancelled claims 4, 18, and 32 and has amended claims 1, 5, 15, 19, 29, and 33 to clarify the embodiments of the invention. Accordingly, claims 1-3, 5-17, 19-31, and 33-42 are pending. Reconsideration of the rejections set forth in the Office Action, in view of the amendments and remarks, is respectfully requested.

I. Drawings

In the Office Action, the drawings were objected to by the Draftsperson as noted in the form PTO 948. Applicant previously submitted formal drawings to the Patent Office. Further, as to the Examiner's objection to the drawings regarding numeral "315". Applicant has amended the specification as suggested by the Examiner to overcome this objection.

II. Specification

The Examiner objected to the Specification for typographical informalities. In response, and in accordance with the Examiner's corrections, Applicant has amended the Specification to correct these informalities, and respectfully requests withdrawal of the objection.

III. Claim Objections

The Examiner objected to claims 10, 11, 24, 25, 38, and 39 for typographical informalities. In response, and in accordance with the Examiner's corrections, Applicant has amended the claims to correct these informalities, and respectfully requests withdrawal of the objection.

IV. Rejection Under 35 U.S.C. § 112

The Office Action rejected claims 4-11 under 35 U.S.C. §112, second paragraph as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. Applicant has amended claim 1 with the limitations of claim 4 and has clarified the claim to overcome the §112 rejection. Applicant respectfully requests that this ground for rejection be removed.

V. Rejection Under 35 U.S.C. § 103

The Office Action rejected claims 1, 4, 5, and 7-42 under 35 U.S.C. §103 as being unpatentable over the admitted prior art, U.S. Patent No. 5,579,447 issued to Salgado. Further, the Office Action rejected claims 2, 3, and 6 under 35 U.S.C. §103 as being unpatentable over Salgado in view of U.S. Patent No. 6,467,054 issued to Lenny.

Claims 1-42 were rejected under 35 U.S.C. §103(a) as being unpatentable over Salgado alone, and/or, in combination with Lenny. Applicant respectfully traverses the Office Action's § 103(a) rejections in their entirety in view of Applicant's amendments to independent claims 1, 15, and 29.

A *prima facie* obviousness rejection requires that three basic criteria be met. First, there must be some teaching, suggestion, or motivation, either in the references themselves, or in the

knowledge generally available to one skilled in the art, to modify the reference or to combine the references. Second, there must be some reasonable expectation of success. Finally, the prior art reference, or references when combined, must teach all of the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. MPEP § 2142; In re Vaeck, 947 F. 2d. 488 (Fed. Cir. 1991).

Further, as more recently and aptly stated by the Federal Circuit in *In re Kotzab*, 55 U.S.P.Q.2D (BNA) 1313, 1316-1317 (Fed. Cir. 2000):

Most if not all inventions arise from a combination of old elements. Thus, every element of a claimed invention may often be found in the prior art. However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant...*Even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference.* (Emphasis added).

Applicant respectfully submits that Salgado, neither alone nor in combination with Lenny and/or "skill in the art", provide a teaching, suggestion, or motivation to alter Salgado in such a way that would render obvious Applicant's amended independent claims 1, 15, 29, all of which at least recite: calling a *scheduling driver* to start an Input/Output (I/O) request to a device for an application, the device being one of a plurality of different types of devices useable by an application...determining if the device is busy...and if the device is not busy...providing an estimated processing time (EPT) for the I/O request to be completed for the application, wherein the application sleeps for the estimated processing time.

In contrast, Salgado teaches:

There is provided *an apparatus* for developing and *displaying* a representation of a *total estimated time to print a job*. The apparatus includes a user interface, with a display screen, for selectively programming the job with plural print related attributes, wherein selected ones of the print related attributes affecting a time required *to print the job*. The apparatus further includes a memory for

storing the image data and the print related attributes as well as a processor for *generating an estimated time to print value* for each of the plural electronic pages based on the selected attributes programmed during said programming which affect the time required to print the job, the estimated time to print generating being performed prior to printing the job. In operation, the processor sums the values generated with the estimated time to print generating for obtaining a total estimated time to print, *wherein the representation of the total estimated time to print is displayed on the display screen*. (Salgado, Abstract, emphasis added).

As more succinctly stated by Salgado, "[t]he present invention relates generally to a technique for *a printing system which stores a previously captured job and prints the same* on demand and, more particularly, to an apparatus and method of *developing and displaying a representation of a total estimated time to print the job*. (Salgado, column 1, lines 5-9, emphasis added). Thus, Salgado teaches *a printing system* that develops and *displays a representation of a total estimated time to print a job*.

This is very different than the embodiments of the invention as set for in Applicant's amended independent claims 1, 15, 29.

In contrast Applicant's amended independent claims 1, 15, 29 recite calling a *scheduling driver* to start an Input/Output (I/O) request to a device for an application, the device being one of a plurality of different types of devices useable by an application. Salgado does not teach, suggest or render obvious *a scheduling driver* to start an I/O request to a device for an application wherein the **device is one of a plurality of different types of devices that are useable by an application**. In fact, Salgado **only teaches estimating a time for a printer**. Nowhere in Salgado is there a mention of a scheduling driver, an application, let alone a scheduling driver to start an I/O request to a device for an application wherein the device is one of a plurality of different types of devices that are useable by an application.

Furthermore, Salgado does not teach, suggest or render obvious the limitation of Applicant's amended independent claims 1, 15, 29 related to providing an estimated processing time (EPT) for the I/O request to be completed for the application, wherein the application sleeps for the estimated processing time. Nowhere, does Salgado teach or suggest providing an estimated processing time (EPT) for the I/O request to be completed for the application, wherein the application sleeps for the estimated processing time.

Although, the Office Action previously cited Salgado column 11, lines 36-40, as being related to this sleeping function, in view of the amendments, Salgado is inapposite. Column 11, lines 31-40 state: "Finally, the technique of the disclosed embodiment *permits the user to obtain information about his/her job relative to other print jobs stored on the associated printing system...* More particularly, in the preferred embodiment, *the user is provided with a display showing each queued job with its corresponding estimated time to compile printing...* Moreover, the cumulative times of the queued jobs are provided so *that the user knows not only how long his/her job should take to print, but at what future moment his/her job will start printing.*" (emphasis added). Nowhere, does this passage of Salgado, nor any other part of Salgado, teach, suggest, or render obvious providing an estimated processing time (EPT) for the I/O request to be completed for the application, wherein the application sleeps for the estimated processing time.

Thus, as outlined above, Applicant respectfully submits that there is no teaching or suggestion in Salgado to render obvious Applicant's embodiments of the invention Applicant's amended independent claims 1, 15, 29 related to: calling a *scheduling driver* to start an Input/Output (I/O) request to a device for an application, the device being one of a plurality of different types of devices useable by an application...determining if the device is busy...and if

the device is not busy...providing an estimated processing time (EPT) for the I/O request to be completed for the application, wherein the application sleeps for the estimated processing time.

Accordingly, Applicant respectfully submits that Applicant's amended independent claims 1, 15, 29 are not rendered obvious by Salgado, either alone or in combination with Lenny. Thus, Applicant respectfully requests that the rejection of amended independent claims 1, 15, and 19 be withdrawn. Further, the dependent claims are allowable for being dependent upon allowable base claims.


CONCLUSION

In view of the remarks made above, it is respectfully submitted that pending claims 1-3, 5-17, 19-31, and 33-42 define the subject invention over the prior art of record. Thus, Applicant respectfully submits that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

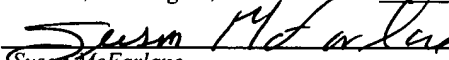
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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on: April 21, 2003.


Susan McFarlane
Date 4/21/03